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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

JACKSON, MONIQUE R

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 09/04/2002

29

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 09/505,713 | | JUD ET AL. | |
| | Examiner | | Art Unit | |
| | Monique R Jackson | | 1773 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The request filed on 6/19/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/505713 is acceptable and a CPA has been established. An action on the CPA follows.
2. The amendment filed 6/19/02 has been entered. Claims 15-19, 21-22, 27-29, and 32-37 have been canceled. New claims 38-54 have been added. Claims 38-54 are pending in the application.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Specification

4. The disclosure is objected to because of the following informalities:
 - Page 1, line 21 – “it necessary” should be “it is necessary” or similar phrase including a similar verb.
 - Page 3, line 5 – “poly-1.4” should be “poly-1,4”.
 - Page 3, line 6 – “polyethylene-2.6” should be “polyethylene-2,6”.
 - Page 4, line 21 – “Coextrud-ed” should be “Coextruded” or “Co-extruded”.
 - Page 5, line 27 – “steril-isable” should be “sterilisable” or more preferably “sterilizable”.
 - Page 7, line 16 – “in particular the of the” should be “in particular, of the”.
 - Page 7, line 35 – “modifiedpolypropylene” should be “modified polypropylene”.Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 54 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 54 recites, “The sterilizable composite film of Claim 53, wherein metal foil (b) is composed of aluminum that has been pretreated on both surfaces by corona pretreatment, a primer layer, which is an epoxy resin or a polyurethane, on at least one surface, and has a thickness of 7 to 15 μm , wherein the polyamide layer of second functional layer (c) is a polycaprolactam and has a thickness of 15 to 25 μm , and the first functional layer (a) is a polyester film, a polyamide film or a polyolefin layer, and has a print layer on the outer surface thereof” in lines 1-7 (emphasis added). Though the Applicant refers to specific portions of the specification as support for this newly added claim, it is noted that the original disclosure including the cited sections does not provide support for (1) an aluminum foil pretreated on both surfaces by corona pretreatment, (2) or a polyamide layer of second functional layer (c) with a thickness of 15 to 25 μm , or (3) a first functional layer of polyester, polyamide or polyolefin with a print layer on the surface thereof, as instantly recited. With regards to the aluminum foil layer, at page 8, lines 9-11, the specification states that the “surface of the metal foil may provide better adhesion properties for the adhesive or lacquer or for an extrusion layer by an appropriate pre-treatment (e.g. brushing, chromate treatment, ionizing treatment, or treatment with ozone, flame or plasma)” but does not recite corona treatment on both sides of the aluminum foil as one of the “appropriate pre-treatment” methods for the metal foil. The paragraph at page 8, line 9,

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continues to recite, “In order to assist and improve the bonding of the lacquer, bonding agents or laminate adhesives between the plastic films or the bonding of extruded layers, it is often useful to provide the film with adequate surface tension on the side facing the adhesive or the extrudate. The increase in surface tension may be achieved advantageously by an ionizing, ozone, plasma, flame or corona pre-treatment” in lines 11-16 (emphasis added.) Hence, the recitation with regards to corona pre-treatment on page 8 refers to the plastic film not the metal foil. In terms of the thickness of the polyamide layer of second functional layer (c) – the coextrusion-coated, coextruded, and/or extrusion-laminated film, the specification recites at page 4, lines 26-32, that the “plastic film of coextruded polyamide/polypropylene may e.g. have a thickness of 30 to 125 μm , usefully 50 to 90 μm and preferably 60 to 80 μm . The thickness of the polyamide layer in the coextrusion coated, coextruded or extrusion laminated polyamide/polypropylene film may make up e.g. 5 to 50% of the total thickness of the coextrusion coated, coextruded or extrusion laminated film, usefully 10 to 30% and preferably 15 to 25%.” Hence, the “15 to 25” refers to a percentage of the “30 to 125 μm , usefully 50 to 90 μm and preferably 60 to 80 μm ” total thickness and not an actual thickness of the polyamide layer in units of μm as instantly recited, and therefore, though the 5-50% of 30-125 μm may include 15-25 μm , the original disclosure does not provide support for the endpoints 15 μm and 25 μm as instantly claimed. Lastly, it is noted that the original disclosure at the time of filing stated that the first functional layer contained “a plastic film of polyester, polyamide or polyolefin OR an extrusion layer of polyolefins OR one or more lacquer layers OR print and lacquer layers OR print layers” at page 1, lines 33-25 and further states, “composite films may exhibit, as a first functional layer a), one or more lacquer coatings or lacquer coatings and print layers on the outside or facing the outside viz., with

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respect to the container made from the film according to the invention. Print layers include in particular material deposited by a printing process over part or the whole of the surface” at page 8, lines 27-30. Based on these sections of the original disclosure, the first functional layer can be selected from a) a plastic film of polyester, polyamide or polyolefin; or b) an extrusion layer of polyolefins; or c) one or more lacquer layers; or d) print and lacquer layers; or e) print layers. The original disclosure at Page 9, lines 22-25 (cited by the Applicant), which recites “in addition to the lacquer coating or coatings or extrusion coatings, print layers or print layers alone are employed”, only provides support for the use of print layers in combination with lacquer coating(s) or extrusion coatings, not in combination with a plastic film of polyester, polyamide or polyolefin” as instantly recited in Claim 54. Hence, from these sections of the original disclosure at the time of filing, it is noted that the “plastic film of polyester, polyamide or polyolefin” and the “print layer(s)” are alternative first functional layers wherein these sections do not disclose the use of both alternatives in combination with each other. Therefore, the original disclosure at the time of filing does not provide support for a first functional layer of polyester film, a polyamide film or a polyolefin layer, that has a print layer on the outer surface thereof as instantly claimed.

7. Claim 54 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 54 recites the limitations “composite film of Claim 53, wherein metal foil (b) is composed of aluminum that has been pretreated on both surfaces by corona pretreatment, a primer layer, which is an epoxy resin or a polyurethane, on at least one surface, and has a thickness of 7 to 15 μ m, wherein the polyamide layer of second functional layer (c) is a

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polycaprolactam and has a thickness of 15 to 25 μm , and the first functional layer (a) is a polyester film, a polyamide film or a polyolefin layer, and has a print layer on the outer surface thereof” in lines 1-7 (emphasis added). However, it is unclear as to whether the “7 to 15 μm ” thickness refers to the metal foil or the primer layer, whether the “on at least one surface” refers to one surface of the composite film or one surface of the metal foil or one surface of the primer layer, and whether “the outer surface thereof” refers to the composite film or the metal foil or the first functional layer. Given the presence of multiple commas in the claim, the Examiner suggests the use of semi-colons or separate lines to differentiate between the various elements of the composite film.

Claim Rejections - 35 USC § 102

8. Claims 38-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Breitler et al (USPN 5,589,275) for the reasons recited previously in paragraph 3 of Paper No. 11, given that new claims 38-53 are the same as prior claims 15-19, 21-22, 27-29, and 32-37 (38~15, 39~16, 40~17, 41~18, 42~19, 43~21, 44~32, 45~33, 46~34, 47~35, 48~27, 49~28, 50~29, 51~22, 52~36, 53~37.)

9. Claims 38-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breitler et al in view of *Ullmann's Encyclopedia of Industrial Chemistry* for the reasons recited previously in paragraph 4 of Paper No. 11, given that new claims 38-53 are the same as prior claims 15-19, 21-22, 27-29 and 32-37.

Conclusion

10. It is noted that the Applicant has not provided any additional arguments regarding the rejections over Breitler et al though the Applicant has recognized that new claims 38-53

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correspond to the prior claims that were rejected for the reasons previously discussed. The Applicant requested a personal interview in Paper No. 21, prior to issuing an office action, however, after a telephone discussion with the Applicant's Attorney, Mr. Virgil Marsh, on August 26, 2002, it was decided that a personal interview could be conducted after a first office action on the CPA.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 703-308-0428. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Monique R. Jackson
Patent Examiner
Technology Center 1700
August 29, 2002